

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants:	LAHTI, Jay et al.	Examiner:	ALTER, Alyssa M.
Serial No.	10/632,026	Group Art:	3762
Filing Date:	July 31, 2003	Docket No.:	P0011616.00
Title:	CONNECTOR ASSEMBLY FOR CONNECTING A LEAD AND AN IMPLANTABLE MEDICAL DEVICE		

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**Pre-Appeal Brief Request for Review**

BOX APPEAL BRIEF  
COMMISSIONER OF PATENTS  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The following is submitted in response to the Advisory Action of February 4, 2011. A Notice of Appeal is submitted herewith. No fee is believed required as this fee has been previously paid.

Entry and consideration of the following is respectfully requested.

Any required fee will be made at the time of submission via EFS-Web. In the event fees are not or cannot be paid at the time of EFS-Web submission, please charge any fees under 37 CFR § 1.16, 1.17, 1.136(a), or any additional fees to Deposit Account 13-2546.

### **Argument**

Claims 1, 3-17, 19-33 and 35-48 were rejected under 35 USC § 103(a) as unpatentable over U.S. Pat. No. 5,769,671 to Lim (Lim) in view of U.S. Pat. No. 4,566,660 to Anscher, et al. (Anscher). This rejection is again respectfully traversed.

In the response to the Final Office Action, Applicants advanced several arguments, all of which will be addressed in detail in the Appeal Brief if necessary. In order to simplify the present filing, Applicants will focus on two simple, clear reasons that the Examiner's obviousness rejection is improper, with the hope that another Appeal Brief will be unnecessary.

As stated in response to the Final Office Action, the claims require that the overlapping ends of the clip in the first position are partially spread apart so that the ends are non-overlapping and aligned so that the first end abuts the second end when the connector clip is in the second position within the housing. This missing teaching is clearly not present in Anscher or suggested by it. Like the clip in Lim, the overlapping free ends of the clip in Anscher are never disclosed as abutting one another in the second position when located in a housing. The Anscher clip isn't even disclosed as locatable within a housing. If the Anscher clip were located in a housing of the type employed in Lim, the intended path of access of the cable (from the side) would be blocked, defeating the basic purpose of the Anscher clip, which is to engage cables in regions far removed from their ends.

In response to this argument, the Advisory Action responds as follows:

Continuation of 11, does NOT place the application in condition for allowance because: The Applicant argues that Lim does not disclose overlapping free ends and Anscher et al. does not disclose a clip with free ends abutting one another when located in a housing. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *in re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *in re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Examiner relies on Anscher et al. to teach the overlapping free ends to snugly hold and engage the lead.

With all due respect, the Examiner's response flatly mis-states Applicant's arguments and cites a text-bite inapplicable to the present situation. Contrary to the Examiner's assertion, Applicants argument was not that the Lim reference doesn't disclose overlapping ends. The argued missing teaching of both references was of abutted, non-overlapping ends while located in the second position in the housing. The Examiner still has not addressed and does not dispute does not dispute the basic fact that this required teaching is absent from both references.

Applicant's argument was that the same required teaching was missing from both the Lim and Anscher references. This is not the situation of In re Keller, and the cited snippet therefrom is inapplicable to the present case.

Because the Examiner's express argument for obviousness is based upon a clear mis-statement of facts and an inapplicable point of law, it necessarily fails to meet the standard of common sense required for a proper section 103 rejection. The Examiner is again respectfully referred to the recently issued Patent Office Guidelines for Section 103 rejections.

Withdrawal of the rejection of all remaining claims over Lim and Anscher is again respectfully requested for this reason, independent of all other arguments made by Applicants..

The only new argument made in the Final Action, upon which all rejections previously also depended, was the following:

“ The Applicant argues that the clip defined by Anscher defines an opening parallel to the path of the cable it connects. However, as depicted in the figures, the connector clip is perpendicular to the axis of the cable. Thus the connector clip as disclosed by Anscher is oriented perpendicular to the insertion axis of orientation of the cable.”

As reflected below, this argument is now expressly withdrawn in the Advisory Action, and the rejection of all claims is now based upon the following new argument as set forth in the Advisory Action:

Additionally, the Applicant argues that the Anscher et al. clip does not have an axis of insertion of the lead perpendicular to the axis of the lead, since the lead is pushed sideways into the clip and not inserted into the central lumen of the clip. Again, the applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 209 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Regardless of the insertion means of Anscher, the Examiner employs Anscher et al. as a teaching reference to teach the overlapping free ends snugly hold and engage the lead or conduit in place. Therefore, it would have been obvious to modify the Lim clip with the free ends of Anscher et al. to snugly engage the lead or conduit. Therefore, the claims remain rejected under Lim in view of Anscher et al. as previously made of record.

However, this new argument does not actually refute or address Applicant's previous argument that:

"Both the clip in the Lim patent and that of the present invention as claimed comprise a "connector clip being oriented perpendicular to the insertion axis of orientation of the proximal end of a lead such that the arms, the non-overlapping ends of the arms, and the top portion together circumscribe an opening through which the proximal end of a lead passes during insertion"; and "Like Darby and the paper clip, in use the Anscher clip defines an opening parallel to the path along which the cable it connects is inserted. Its operational mechanism is thus directly contrary to that required by the claims."

The Examiner now takes the position that such a modification is obvious because "it would have been obvious to modify the Lim clip with the free ends of Anscher, et al to snugly engage the lead."

With all due respect, the argument fails to meet the standard of common sense. The free ends of the Lim clip do not engage the lead when inserted. They are unambiguously intended not to engage the lead body. If the free ends of the Anscher clip were substituted, they presumably also would not engage the lead body. The result of the Examiner's proposed substitution thus does not obviously provide the resulting benefit which the Examiner argues makes the substitution obvious in the first place. It is respectfully asserted that for this

reason, the Examiner's new argument is clearly contrary to common sense and thus improper.

Withdrawal of the rejection of all remaining claims over Lim and Anscher is respectfully requested for this reason, independent of all other arguments made by Applicants.

As a side note, the rampant practice of offering arguments in Advisory Actions based upon interpretations of the prior art inconsistent with those in the Final Office Actions is one of the reasons that the Patent Office is over-run with RCE applications. It is respectfully suggested that this practice should be curtailed. New interpretations of prior art references which are contradictory to previous interpretations should be set forth in new Office Actions, not Advisory Actions.

In view of the above, Applicants respectfully request reconsideration and withdrawal of the above rejection of claims 1, 3-17, 19-33 and 35-48 under 35 U.S.C. § 103(a).

Presumably the Examiner has finished with all of the searching she is going to do. It is respectfully asserted that the time has come to allow this application to issue. The time and expense associated with an additional appeal brief is respectfully asserted to be unjustified. Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone Reed Duthler at (763) 526-1564 to attend to these matters.

Respectfully submitted,

Date: March 3, 2011

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